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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/426,954
Filing Date: October 26, 1999
Appellant(s): FUSZ, EUGENE AUGUST

Robert E. Slenker
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 7, 2004.

(1)   Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2)   Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly

affect or be directly affected by or have a bearing on the decision in the pending appeal

is contained in the brief.

(3)   Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4)   Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5)   Summary of Invention

The summary of invention contained in the brief is correct.

(6)   Issues

The appellant's statement of the issues in the brief is correct.

(7)   *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 3-17, 19-26, and 28 do not

stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and

(c)(8).

Group 1 includes claims 1 and 3-7.

Group 2 includes claims 8-15.

Group 3 includes claims 16, 17, and 19-21.

Group 4 includes claims 22-26 and 28.

(8)   *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   *Prior Art of Record*

| 5,855,008 | Goldhaber et al | 12-1998 |
| 6,009,411 | Kepecs | 12-1999 |

(10)   *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-17, 19-26, and 28 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Goldhaber et al (USPN 5,855,008), in view of Kepecs (USPN

6,009,411).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-17, 19-26, and 28 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Goldhaber et al (USPN 5,855,008), in view of Kepecs (USPN

6,009,411).

<u>Claim 1</u>

Goldhaber et al disclose a method for prompting an individual to create an

anonymous data profile for the individual (see column 6, lines 40-44), comprising the

steps of providing the individual with access to a database (consumer database 120,

see column 12, lines 21-24), requesting anonymous profile information, about the

individual be entered into the database (see column 12, lines 28-30), and compensating

the individual for either or both of entry of the anonymous profile information and

feedback provided in response to marketing data (see column 10, lines 46-53).

Goldhaber et al does not disclose maintaining the anonymity of the individual

through an inability to accept contact information in the profile. Kepecs discloses a

method of distributing and redeeming promotions wherein no consumer identification is

maintained (see column 2, lines 50-52). The lowest level of identification in Kepecs is

simply a unique customer key with no other identification data (see column 6, lines 51-

53), wherein the consumer is compensated via a discount or credit (see column 5, lines

41-45), identified via the key (see column 5, lines 55-57).

Both Goldhaber and Kepecs are concerned with an effective method of

marketing products to potential consumers, therefore it would have been obvious to one

having ordinary skill in the art at the time the invention was made to include maintaining

the anonymity of the individual through an inability to accept contact information in the

profile in the Goldhaber et al method, as seen in Kepecs, thus providing complete

privacy for the individual, thereby increasing the number of consumers that would

otherwise be reluctant to use a method which requires identifying information.

Claim 8

Goldhaber et al disclose a method for providing advertising feedback (see

column 10, lines 39-42), comprising the steps of administering to each individual a

password, absent any contact information for the individual, (see column 13, line 22),

utilizing the password to access a database (consumer database 120), entering profile

information for the individual in the database (see column 12, lines 39-42), storing the

entered profile information in the database (see column 13, lines 28-30), presenting at

least one of the individuals with a set of data, receiving feedback regarding the set of

data (see column 16, lines 16-19), and compensating the at least one individual for the

feedback (see column 16, lines 19-23).

Goldhaber does not disclose maintaining the anonymity of the individual through

an inability to accept contact information in the profile. Kepecs discloses a method of

distributing and redeeming promotions wherein no consumer identification is maintained

(see column 2, lines 50-52). The lowest level of identification in Kepecs is simply a

unique customer key with no other identification data (see column 6, lines 51-53) ,

wherein the consumer is compensated via a discount or credit (see column 5, lines 41-

45), identified via the key (see column 5, lines 55-57).

Both Goldhaber and Kepecs are concerned with an effective method of

marketing products to potential consumers, therefore it would have been obvious to one

having ordinary skill in the art at the time the invention was made to include maintaining

the anonymity of the individual through an inability to accept contact information in the

profile in the Goldhaber et al method, as seen in Kepecs, thus providing complete

privacy for the individual, thereby increasing the number of consumers that would

otherwise be reluctant to use a method which requires identifying information.

Claim 16

Goldhaber et al disclose an apparatus for conveying and storing information

relating to anonymous data profiles (see column 6, lines 40-44), comprising a first data

repository, a first computer linked to the first data repository (see column 12, lines 39-

42), configured to communicate with the first data repository via a password (see

column 13, line 22), provide a first set of information about the individual to the first data

repository (see column 13, lines 28-30), and a processor programmed to communicate

with the first data repository and the first computer (software agents 101, see column 9,

lines 53-56). Goldhaber et al disclose a second data repository, a second set of

computers linked to the second data repository, the second set of computers configured

to provide a plurality of second sets of information to the second data repository

(servers 106, see column 9, lines 62-67), the first data repository separate from the

second data repository, the processor (software agents 110) further programmed to

communicate with the second data repository and the second set of computers (see

column 9, lines 58-61), the processor also programmed to receive and store feedback

regarding the second sets of information, and provide compensation data to the first

data repository and linked to the first information sets (feedback stored by servers 106

and compensation routed through consumer computer 104).

Goldhaber et al do not disclose the first set of information lacking information

relating to a name, an address, a telephone number, and a social security number of

the individual, through an inability to accept such information into the first computer.

Kepecs discloses distributing and redeeming promotions wherein no consumer

identification is maintained (see column 2, lines 50-52). The lowest level of

identification in Kepecs is simply a unique customer key with no other identification data

(see column 6, lines 51-53) , wherein the consumer is compensated via a discount or

credit (see column 5, lines 41-45), identified via the key (see column 5, lines 55-57).

Both Goldhaber and Kepecs are concerned with an effective method of

marketing products to potential consumers, therefore it would have been obvious to one

having ordinary skill in the art at the time the invention was made to include maintaining

the anonymity of the individual through an inability to accept contact information in the

profile in the Goldhaber et al method, as seen in Kepecs, thus providing complete

privacy for the individual, thereby increasing the number of consumers that would

otherwise be reluctant to use a method which requires identifying information.

Claim 22

Goldhaber et al disclose a system for generating advertising feedback from

anonymous consumers via an electronic data communications network (overall

environment, see column 9, lines 33-36), comprising a control unit for coupling to the

communications network (consumer computers with software agents, see column 9,

lines 53-56), a server (servers/attention brokers 106, see column 9, lines 37-38 and 62-

63) coupled to the control unit comprising a consumer generated database for storing

profile information related to consumers, a marketer database for storing information to

be reviewed by consumers, and a processor programmed (software agents 110, see

column 9, lines 53-61) to receive consumer generated data sets controlled by the

consumers, each data set including a set of individual characteristics, the processor

further programmed to download the consumer generated data sets into the consumer

generated database (see column 13, lines 28-30), receive controlled information from

marketers, the processor further programmed to download marketer generated data into

the marketer database (see column 16, lines 26-29), comparing the marketer generated

data set to each consumer generated data set, and if the marketer generated data is

identified as matching one or more of the individual characteristics of the consumer

generated data sets, designating the marketer generated data set to be communicated

to the consumer (see column 16, lines 30-35), the processor also programmed to

receive feedback from the anonymous consumers regarding the marketer generated

data, the system configured to provide compensation to the anonymous consumers for

the feedback (feedback stored by servers 106 and compensation routed through

consumer computer 104).

Goldhaber et al do not disclose refusing a name, an address, a telephone

number, and a social security number of the consumer, and the database having an

inability to accept contact information. Kepecs discloses distributing and redeeming

promotions wherein no consumer identification is maintained (see column 2, lines 50-

52). The lowest level of identification in Kepecs is simply a unique customer key with no

other identification data (see column 6, lines 51-53), wherein the consumer is

compensated via a discount or credit (see column 5, lines 41-45), identified via the key

(see column 5, lines 55-57). Both Goldhaber and Kepecs are concerned with an

effective method of marketing products to potential consumers, therefore it would have

been obvious to one having ordinary skill in the art at the time the invention was made

to include maintaining the anonymity of the individual through an inability to accept

contact information in the profile in the Goldhaber et al method, as seen in Kepecs, thus

providing complete privacy for the individual, thereby increasing the number of

consumers that would otherwise be reluctant to use a method which requires identifying

information.

(11)   Response to Argument

In the Appeal Brief, with respect to claims 1, 8, 16, and 22, Appellant argues that

1) neither Goldhaber et al nor Kepecs teach an anonymous data profiling method and

system, 2) Goldhaber et al provides no suggestion of teaching of an inability to accept

contact information, 3) Kepecs does not teach an inability to accept contact information,

and 4) that there is no motivation to combine the teachings of Kepecs with Goldhaber et

al.

With respect to argument 1, Appellant asserts that neither Goldhaber et al nor

Kepecs teach or suggest an anonymous data profiling method and system. The

Examiner respectfully disagrees and submits that the combination of Goldhaber et al in

view of Kepecs indeed discloses Appellant's invention, since the combination of

references teaches each and every limitation of Appellant's claim language, as seen in

the above rejections of the claims. Further, there is also motivation to combine the

references, as required under 35 USC § 103 in order to establish a proper prima facie

obviousness rejection, as later discussed with respect to argument 4. In addition,

Appellant's argument 1, that neither Goldhaber et al nor Kepecs teach or suggest an

anonymous data profiling method and system, is merely a broad assertion that does not

point to any specific claim language. In fact, argument 1 merely references Appellant's

preamble of claims 1, 16, and 22. The Examiner submits that a preamble is generally

not accorded any patentable weight where it merely recites the purpose of a process or

the intended use of a structure, and where the body of the claim does not depend on

the preamble for completeness but, instead, the process steps or structural limitations

are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and

Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

With respect to argument 2, Appellant asserts that Goldhaber et al provides no

suggestion of teaching an inability to accept contact information. The Examiner

respectfully contends that this argument is moot, since Kepecs is used to teach that

particular limitation of the claims, as seen in the above rejections.

With respect to argument 3, Appellant asserts that Kepecs does not teach an

inability to accept contact information. The Examiner respectfully disagrees, and

submits that Kepecs discloses a lowest level of identification being a unique key (i.e.,

account identification) with no other consumer identification data (column 6, lines 52-

59). This particular embodiment, as disclosed by Kepecs, includes no other contact

identification or information, and indeed discloses Appellant's limitation of maintaining

the anonymity through an inability to accept contact information in the profile.

Identifying the consumer by the key **only**, includes both an inability to store and an

inability to accept contact information. Any additional inclusion or acceptance of

information would **not** be included in the **lowest level of identification**, but in other

levels of identification, as disclosed by Kepecs. In addition, Appellant argues that the

consumers do not appear to be anonymous with respect to the retailers or financial

institutions. This assertion is incorrect. By using the lowest level of identification, the

consumer is actually not identifiable by the discount administration process (DAP)

system, the retailers, or financial institutions. Appellant's citations to various portions of

Kepecs, refer to other levels of identification, not the lowest level of identification.

Further, Kepecs discloses that the knowledge of the key does not compromise the

security of the system, since the consumer's identity is unavailable for harassment

(column 7, lines 54-56).

Appellant goes on to argue that the key in the DAP system is networked to other

computer systems, at least some of which may associate the key with consumer

identifying accounts. The Examiner respectfully disagrees with Appellant's

interpretation of Kepecs. Merely being networked to other computers does not destroy

the anonymity of the lowest level of identification. Actually, being anonymous to DAP,

via the lowest level of identification, allows the consumer to remain anonymous when

accessing their account (column 6, lines 45-47) and knowledge of the key does not

compromise the security of the system, since the consumer's identity is unavailable for

harassment (column 7, lines 54-56).

With respect to argument 4, Appellant argues that there is no suggestion to

combine the references. The Examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the

claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

both Goldhaber et al and Kepecs are concerned with an effective method of marketing

products to potential consumers, via consumers profiles. In addition, Kepecs discloses

an exchange of benefits between the consumer and discounter, in return for information

regarding the consumer's interests (column 4, lines 10-14). This is similar to Appellant's

claim language of compensating an individual for entry of profile information and/or

feedback, as seen in claims 1, 8, 16, and 22. More importantly, this exchange of

benefits for information regarding the consumer profile, provides motivation to be

combined with the consumer interest profile 124, as seen in Goldhaber et al, which is

also exchanged for benefits (i.e., compensation to the consumer). However, since the

consumer profile 124 in Goldhaber et al does not have an inability to accept contact

information, Kepecs is used in combination, thereby resulting in an anonymous

identification of the consumer, whereby the consumer's identity is unavailable for

harassment, as disclosed by Kepecs (column 7, lines 53-57).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Andre Boyce

adb
January 6, 2005

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